

REMARKS

This Amendment is in response to the Office Action of October 29, 2003. Applicants respectfully submit that all the claims presently on file are in condition for allowance, which action is earnestly solicited.

ELECTION/RESTRICTIONS

Claims 27-46 were withdrawn from consideration for being "directed to an invention that is independent or distinct from the invention originally claimed". Accordingly, Applicants have canceled claims 27-46, without prejudice.

CLAIMS REJECTION - 35 USC §112

Claims 21-26 were rejected under 35 USC §112, second paragraph, for including an informality. This informality has now been corrected in satisfaction of 35 USC §112.

CLAIMS REJECTION UNDER 35 U.S.C. §103

Claims 1-33 are rejected under 35 U.S.C. §103(a) as being unpatentable over Published International Patent Application WO 00/31657 by Van Den Berghe et al. ("PCT application"), in view of USPN 6,125,352 granted to Franklin et al. ("Franklin"), hereinafter also collectively referred to as the "cited references". Applicants respectfully traverse this rejection and submit that the claims as amended, are not obvious in view of the cited references, and are thus patentable thereover. In support of this position, Applicants submit the

following arguments.

A. Legal Standard for Obviousness

The following legal authorities set the general legal standards in support of Applicants' position of non obviousness, with emphasis added for added clarity:

- MPEP 706.02(j), "**To establish a prima facie case of obviousness, three basic criteria must be met.** First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991)* ... The initial burden is on the examiner to provide some **suggestion of the desirability** of doing what the inventor has done. 'To support the conclusion that the claimed invention is directed to obvious subject matter, either the **references must expressly or impliedly suggest the claimed invention** or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.' *Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).*"
- **In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is** not whether the differences themselves would have been obvious, but **whether the claimed invention as a whole would have been obvious.** The prior art perceived a need for mechanisms to dampen resonance, whereas the inventor eliminated the need for dampening via the one-piece gapless support structure. "Because that insight was contrary to the understandings and expectations of the art, the structure effectuating it would not have been obvious to those skilled in the art." *713 F.2d at 785, 218 USPQ at 700* (citations omitted).

- MPEP §2143.03, "All Claim Limitations Must Be Taught or Suggested: To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970). If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988)."
- MPEP §2143.01, "The Prior Art Must Suggest The Desirability Of The Claimed Invention: There are three possible sources for a motivation to combine references: the nature of the problem to be solved, the teachings of the prior art, and the knowledge of persons of ordinary skill in the art." *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457-58 (Fed. Cir. 1998) (The combination of the references taught every element of the claimed invention, however without a motivation to combine, a rejection based on a prima facie case of obvious was held improper.). The level of skill in the art cannot be relied upon to provide the suggestion to combine references. *Al-Site Corp. v. VSI Int'l Inc.*, 174 F.3d 1308, 50 USPQ2d 1161 (Fed. Cir. 1999).
- "Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination." *In re Fine*, 837 F.2d at 1075, 5 USPQ2d at 1598 (citing *ACS Hosp. Sys. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984)). What a reference teaches and whether it teaches toward or away from the claimed invention are questions of fact. See *Raytheon Co. v. Roper Corp.*, 724 F.2d 951, 960-61, 220 USPQ 592, 599-600 (Fed. Cir. 1983), cert. denied, 469 U.S. 835, 83 L. Ed. 2d 69, 105 S. Ct. 127 (1984). "
- "When a rejection depends on a combination of prior art references, there must be some teaching, suggestion, or motivation to combine the references. See *In re Geiger*, 815 F.2d 686, 688, 2 USPQ2d 1276, 1278 (Fed. Cir. 1987)." Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See MPEP 2143.01; *In re Kotzab*, 217 F.3d 1365, 1370, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000); *In re Fine*, 837

F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988); and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

- "With respect to core factual findings in a determination of patentability, however, the Board cannot simply reach conclusions based on its own understanding or experience -- or on its assessment of what would be basic knowledge or common sense. Rather, the Board must point to some concrete evidence in the record in support of these findings." See *In re Zurko*, 258 F.3d 1379 (Fed. Cir. 2001).
- "We have noted that evidence of a suggestion, teaching, or motivation to combine may flow from the prior art references themselves, the knowledge of one of ordinary skill in the art, or, in some cases, from the nature of the problem to be solved, see *Pro-Mold & Tool Co. v. Great Lakes Plastics, Inc.*, 75 F.3d 1568, 1573, 37 USPQ2d 1626, 1630 (Fed. Cir. 1996), *Para-Ordinance Mfg. v. SGS Imports Intern., Inc.*, 73 F.3d 1085, 1088, 37 USPQ2d 1237, 1240 (Fed. Cir. 1995), although "the suggestion more often comes from the teachings of the pertinent references," *Rouffet*, 149 F.3d at 1355, 47 USPQ2d at 1456. The range of sources available, however, does not diminish the requirement for actual evidence. That is, the showing must be clear and particular. See, e.g., *C.R. Bard*, 157 F.3d at 1352, 48 USPQ2d at 1232. Broad conclusory statements regarding the teaching of multiple references, standing alone, are not "evidence." E.g., *McElmurry v. Arkansas Power & Light Co.*, 995 F.2d 1576, 1578, 27 USPQ2d 1129, 1131 (Fed. Cir. 1993) ("Mere denials and conclusory statements, however, are not sufficient to establish a genuine issue of material fact."); *In re Sichert*, 566 F.2d 1154, 1164, 196 USPQ 209, 217 (CCPA 1977)." See *In re Dembicza*k, 175 F.3d 994 (Fed. Cir. 1999).
- "To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show a motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventor and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed." See *In re Rouffet*, 149, F.3d 1350 (Fed. Cir. 1998).
- The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430

(Fed. Cir. 1990). Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992) (flexible landscape edging device which is conformable to a ground surface of varying slope not suggested by combination of prior art references).

- If the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

B. Brief Summary of the Present Invention

B.1. Problems addressed by present invention

Prior to presenting substantive arguments in favor of the allowability of the claims on file, it might be desirable to summarize the present invention in view of the problems it addresses. One of the problems addressed by this present invention is exemplified as follows: While the conventional e-shopping service enables the shopper to search for multiple items in a single search, it does not provide the shopper with the ability to purchase all the items in the shopping cart. Instead, the e-shopping service merely provides a list of links to the vendors' sites so that the shopper could link to these sites and complete the purchases, one vendor at a time.

Furthermore, while the foregoing e-shopping model could provide a combined search result and an incentive for purchasing items from multiple vendors, this purpose is practically defeated because the foregoing e-shopping model does not facilitate the shopping experience. After comparison

shopping, the user must still visit each of the vendors' sites separately in order to consummate the purchases from the combined result.

Accordingly, the foregoing e-shopping model, which is representative of current e-shopping services, does not adequately address the shoppers' need for an intuitive interface with the vendors' sites to complete numerous purchases from heterogeneous vendors. In particular, shoppers are not afforded the ability to search for an item from the general population of web-based vendors. Moreover, shoppers are not provided with a true "shopping cart" that permits both a price comparison of a set of heterogeneous items and the ability to purchase those items directly from the vendors. Furthermore, the scope of heterogeneous items that may be searched is limited and does not adequately address the diverse goods and/or services that shopper may wish to purchase in a single shopping excursion.

Existing solutions to the foregoing problem propose opening up multiple instances of a browser and establish connections between the client and multiple web sites. The information "collected" in each session could then be "cut and pasted" together in a wallet and presented to the shopper for the purchasing decision. Such an approach is quite impractical because of the significant amount of processing resources that would be consumed by the opening up and maintaining of multiple browser instances.

B.2. Present Invention

In summary, the present invention allows the shoppers to, not only compare the price of heterogeneous items, but also to purchase these items directly without having the user visit each of the merchants' web sites individually.

When used by current comparison shopping web-sites, the system of the present invention transforms those sites into active shopping agent sites.

Shoppers will be able to use these shopping agent sites to perform research about products and prices. Existing web-based comparison shopping sites, for example at <http://www.mysimon.com>, can be used to perform the comparison shopping function.

In addition, the method of the invention will provide an automated buying process for all selected items within a single virtual shopping cart. A shopping agent web site using the system of the invention would become a shopping portal site, satisfying all the shopping needs of the users.

C. PCT Application

The PCT application generally describes a Multi-Site Shopping Cart system which enables portals and merchants to form a Cooperative Sales relationship across a computer network. It provides a system that presents the customer with a single shopping cart interface which enables her to purchase items from several distinct merchants at a single location, with just a single click of the mouse.

The system provides two components: an Application Server (APS) that controls the content of the Multi-Site cart and stores the user information; and a Parsing Proxy Server (PPS) that acts as an intermediary between the user and the merchants, when the user is browsing the merchant Web sites.

At the beginning of the users shopping session, the APS serves pages with links to the merchant Web sites. These links are routed through the PPS in the following manner: the user's browser requests a page from the PPS, which in turns requests a page from the merchant site, processes this page, and then serves it to the browser. The minimum level of processing done by the PPS consists of finding the links in the HTML page of the merchant and ensuring that all these links are modified to route through the PPS. This means that, as the user clicks on links in the page, all of the browser requests are sent to the PPS.

If the merchant pages contain some information on the items selected by the user, the PPS extracts this information and sends it to the APS, using the HTTP protocol. If the page to be served is the merchant's shopping cart page, the PPS performs a re-direct to the APS, and the APS displays the Multi-Site Shopping Cart page which includes the item just selected on the merchant site.

When the user is ready to execute the purchase, she can select a sub-set of her shopping cart. She can then click on a "buy" button. The APS instructs the PPS to re-create, on the merchant sites, the shopping carts corresponding to the selected items, and then to place an order using the user's billing and shipping information. This interaction is performed by a bot, which is a component of the PPS, either by simulating the user's clicks on the merchant

site or by using the merchant's own API, if available. Alternatively, the user can go to the merchant's web site through the PPS, and perform a manual checkout process as implemented by the merchant. In that case, the PPS will help the user by filling the forms with the user's information.

D. Independent Claims 1, 9, 11, and 18

Applicants will now present arguments in support of the allowance of independent claims 1, 9, 11, and 18, and the claims dependent thereon, over The PCT application. Claim 1, as a representative claim, recites the following elements that are not described in The PCT application:

“1. A system for automating an electronic-commerce transaction using a virtual shopping cart initiated at a host site, comprising:
a merchant schema database that contains information about schemas used by a plurality of **heterogeneous and unrelated merchants' sites**;
a shopping cart manager that creates the virtual shopping cart based on a user's search query, and that monitors the content of the virtual shopping cart;
a comparison shopping engine that automatically collects and manages information from the plurality of heterogeneous and unrelated merchants' sites, across multiple independent transaction sessions initiated by the host site, based on the user's search query, and that **returns a corresponding comparative search result, without requiring the user to leave the host site to visit** the plurality of heterogeneous and unrelated merchants' sites **while the comparison shopping engine is automatically collecting and managing information from the plurality of heterogeneous and unrelated merchants' sites**; and
a protocol broker module that selectively communicates with the plurality of heterogeneous and unrelated merchants' sites using at least one of the schemas in the merchant schema database, in order to execute a transaction for each item in the virtual shopping cart.”
(Emphasis added).

D. 1. First Distinguishable Element

Applicants have amended claim 1 to clarify that, contrary to the merchants' sites in the PCT application, the heterogeneous merchant's sites of the present invention do not need to be related by any prior relationship, such as a contractual relationship. This is a very important aspect of the present invention in that it renders the present invention implementable, for example, over the entire Internet, and not just over a network of selected merchants that are tied by a prior arrangement. It is quite apparent that such a distinction would provide the consumers with a clear purchasing advantage, in that it provides a wider, unbiased selection of products or services to the consumers.

In addition, consider the example, where a consumer using the system described in the PCT application, wishes to select an independent merchant who is not contracted by the system, the consumer will need to exit the system and use other means to access the independent merchant. This is a clear teaching away from the present invention.

D. 2. Second Distinguishable Element

Applicants agree with the Examiner that Van Den Berghe et al. (the PCT application) do not specifically disclose a comparison shopping engine. This missing element is quite important to the proper implementation of the present invention in that it enables (1) the consumer to have a broad access to the entire Internet, as discussed earlier; and (2) it enables the consumer to conduct his/her shopping without having to leave the host site.

The Examiner based the rejection on the following ground: "(although comparison shopping would be enabled by the system of Van Den Berghe et al., since a user would be enabled to shop for the same item at a number of different sites). Franklin et al. teach (see abstract) an e-commerce shopping cart system allowing comparison shopping (see abstract), which is clearly desirable in order to ensure a user is paying the lowest price for a product. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate a comparison shopping engine into the electronic commerce system of Van Den Berghe et al. in order to ensure a user is paying the lowest price for a product."

Applicants respectfully respond by submitting that "comparison shopping" taken individually, and out of the context of the present invention is not new. Applicants make reference in the present application to an exemplary comparison shopping site, i.e., mysimon.com. However, and as stated earlier, the obviousness test is that in "determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious."

Since the main reference, namely the PCT application, does not recite this essential element of the present invention, the design resulting from the hypothetical combination of the cited references, would not render the present invention legally obvious.

In addition, and as stated earlier, "[w]hen a rejection depends on a combination of prior art references, there must be some teaching, suggestion,

or motivation to combine the references." Applicant respectfully submits that the motivations or suggestions provided in the office action do not provide sufficient suggestion of the desirability of doing what the inventor has done in that the cited references do not expressly or impliedly suggest the claimed invention.

In support of this statement, Applicants submit that one of the motivations to combine the cited references is as follows: "It would have been obvious and desirable to use an index to reference the hyperlinks contained in the document because the index numbers could contain much less data than encoding the actual hyperlink into a barcode on the document and thus the index barcode would have taken up significantly less space on the paper document." Emphasis added. The foregoing justification describes a "general interest," and does not meet the burden of proving obviousness, since this justification does not consider the invention as a whole.

Furthermore, and as discussed earlier, even if the two cited references were to be combined, the resulting design would still not be similar to that of the present invention. Please refer to the example above, wherein the system of the PCT application does not allow a user to access a non-participating, contracted merchant.

To conclude, independent claims 1, 9, 11, and 18 are allowable, and thus the claims dependent thereon are also allowable, and such allowance is respectfully requested.

CONCLUSION

All the claims presently on file in the present application are in condition for immediate allowance, and such action is respectfully requested. If it is felt for any reason that direct communication would serve to advance prosecution of this case to finality, the Examiner is invited to call the undersigned at the below-listed telephone number.

Respectfully submitted,



Date: January 29, 2004

Samuel A. Kassatly Law Office
6819 Trinidad Drive
San Jose, CA 95120
Tel: (408) 323-5111
Fax: (408) 323-5112

Samuel A. Kassatly
Attorney for Applicants
Reg. No. 32,247
Tel. (408) 323-5111